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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,052	02/16/2000	Donald R. Russell	P96005US2B	6415

7590 12/19/2002

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EXAMINER

HORTON, YVONNE MICHELE

ART UNIT PAPER NUMBER

3635

DATE MAILED: 12/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/505,052

Applicant(s)  
Donald R. Russell et al.

Examiner  
YVONNE M. HORTON

Art Unit  
3635



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jul 30, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 27 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim requires a 100% solids tape; however the specification has not clearly set forth what it is that defines the tape as being a "100% solids" tape. Clarification is required.

### ***Claim Rejections - 35 USC § 102***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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5. Claims 8-15,24 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #3,937,640 to TAJIMA et al. In reference to claims 8 and 27, TAJIMA et al. discloses a method for applying a walkway pad (26) to a roofing membrane (35) including the steps of providing a walkway pad (26); applying a solids tape (20) to a planar surface of the pad (26); applying the walkway pad (26) to a rooftop (unlabeled) by placing an exposed surface of the tape (20) to an upper surface of the rooftop. Regarding claim 9, the tape (20) is disposed about the back surface "proximal" the edges of the pad (26). In reference to claim 10 the walkway pads (26) are rubber-based, column 3, lines 50-60. Regarding claim 11, the tape comprises EPDM, column 6, line 19. In reference to claim 12, the walkway pads (26) are rubber-based, column 3, lines 50-60 and the tape comprises EPDM, column 6, line 19. Regarding claim 13, the roof area is prepared prior to removal of the release paper, column 11, line 64. In reference to claim 14 and in further regards to claim 27, the tape (20) is applied at the place of manufacture. Regarding claim 15, the pad (26) may be applied also without priming. In reference to claim 24, the method further includes removing the release paper.

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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***Claim Rejections - 35 USC § 103***

7. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,937,640 to TAJIMA et al. Regarding claim 1, TAJIMA et al. discloses a method for applying a walkway pad (26) to a roofing membrane (35) including the steps of providing a walkway pad (26); applying a solids tape (20) to a planar surface of the pad (26) where the tape includes a release paper (14,15); removing the release paper (14,15); and applying the walkway pad (26) to a rooftop (unlabeled) by placing an exposed surface of the tape (20) to an upper surface of the rooftop. TAJIMA et al. discloses the basic claimed method except for the step of applying a force. Although TAJIMA et al. is silent in this regard, it would have been obvious to one having ordinary skill in the art at the time the invention was made that a force be applied to the walkway (26) in order to increase the surface adhesion and ensure attachment between the pads (26) and the roofing membrane (35). In reference to claim 2, the walkway pads (26) are rubber-based, column 3, lines 50-60. Regarding claim 3, the tape comprises EPDM, column 6, line 19. In reference to claim 4, the walkway pads (26) are rubber-based, column 3, lines 50-60 and the tape comprises EPDM, column 6, line 19. Regarding claims 6 and 7, the roof area is prepared prior to removal of the release paper, column 11, line 64.

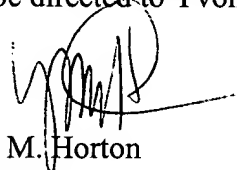
8. Claims 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,937,640 to TAJIMA et al. Regarding claim 1, TAJIMA et al. discloses a method for applying a walkway pad (26) to a roofing membrane (35) including the steps of preparing a walkway pad (26) and bundling the walkway pads (26), column 1, lines 60-61. TAJIMA et al. discloses the

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basic claimed method except for the step of delivering the walkway pads (26). Although TAJIMA et al. is silent in this regard, it would have been obvious to one having ordinary skill in the art at the time the invention was made that a force be applied to deliver the pads (26) to persons for application thereof. In reference to claim 17, the walkway pads (26) are rubber-based, column 3, lines 50-60. Regarding claim 18, the tape comprises EPDM, column 6, line 19. In reference to claim 19, the walkway pads (26) are rubber-based, column 3, lines 50-60 and the tape comprises EPDM, column 6, line 19. Regarding claim 20, the tape (20) is disposed about the back surface "proximal" the edges of the pad (26). In reference to claim 21 and in further regards to claim 27, the tape (20) is applied at the place of manufacture. Regarding claim 22, the pad (26) may be applied also without priming. As best understood, the tape (20) is a 100% solids tape.

***Response to Arguments***

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (703) 308-1909.



Yvonne M. Horton  
Art Unit 3635  
December 16, 2002